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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IAN M. DRYSDALE and CHARLES A. FILLINGER

Appeal 2008-0627
Application 09/812,036
Technology Center 2100

Decided: July 3, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 18-28 and 38-44. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

THE INVENTION

The disclosed invention relates generally to providing an electronic communication to a personal wireless device user. More particularly, Appellants' invention relates to a method and system for providing a targeted electronic communication to a personal wireless device user when the personal wireless device enters the proximity of a commercial facility (*see* Spec. 1).

Independent claim 18 is illustrative:

18. A method for a facility communication system within a commercial establishment to provide a targeted electronic communication to a user entering the establishment and having a personal wireless device, comprising the steps of:

storing user specific information in a storage location;

providing the personal wireless device with a transceiver device;

recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment and the personal wireless device is within a predetermined distance from the facility communication system;

sending a request for user specific information from the facility communication system to the personal wireless device;

retrieving the user specific information;

sending the user specific information from the personal wireless device to the facility communication system;

comparing the user specific information to predetermined criteria;

sending a targeted electronic communication to said personal wireless device corresponding to the user specific information; and

displaying the targeted electronic communication at the personal wireless device so that the communication may be used by the user while present in the commercial establishment.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejection:

Laor	US 6,584,448 B1	Jun. 24, 2003
Ludtke	US 2002/0138372 A1	Dec. 11, 2001
Hudda	US 2001/0049636 A1	Apr. 16, 2001

THE REJECTION

Claims 18-28 and 38-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hudda in view of Laor and Ludtke.

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d

1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Brief to show error in the proffered prima facie case.

ISSUE(S)

We decide the question of whether Appellants have shown the Examiner erred in holding that the cited references render obvious the claimed subject matter. More particularly, we have determined that the following issue is dispositive in this appeal:

Whether Appellants have shown that the Examiner erred in finding that the cited references teach and/or suggest recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment and the personal wireless device is within a predetermined distance from the facility communication system, as claimed.

ANALYSIS

After reviewing the record before us, we address the arguments presented in the Brief only to the extent that Appellants' arguments are directed to claimed subject matter. Patentability is based upon the claims. "It is the claims that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*).

Elements under 35 U.S.C. § 103

Claims 18-28 and 38-44

We consider the Examiner's rejection of claims 18-28 and 38-44 as being unpatentable over Hudda, Laor, and Ludtke. Since Appellants' arguments have treated these claims as a single group which stand or fall

together, we select independent claim 18 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

At the outset, we broadly but reasonably construe the claimed “recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment,” as an acknowledgment of the personal wireless device while within the commercial establishment. In other words, the language of claim 18 does not require that recognition of the wireless device is necessarily triggered by the user of the wireless device entering the establishment.

Appellants contend that the Examiner failed to set forth a *prima facie* case because the cited references fail to teach all of the limitations recited in claim 18. (*See* App. Br. 4, ll. 6-15). In particular, Appellants contend that the prior art references fail to teach the recognition of the presence of the wireless device when entering a commercial establishment and/or sending a

request for user specific information from the facility communication system in response to recognizing the presence of the personal wireless device, as recited in claim 18. (App. Br. 5, ll. 15-17 and 24-29).

With regards to the above, we note the following: Regarding Appellants' assertion that the cited references fail to teach "sending a request for user specific information from the facility communication system in response to recognizing the presence of the personal wireless device" *id.*, we note that claim 18 does not recite "in response to" and therefore we decline to read this limitation into the claim. In other words, it is our view that the recited "sending a request" limitation is not based on the "recognition" limitation, as asserted by Appellants, and is, in fact, a separate limitation, unaffected by the limitation of "recognizing the presence of the wireless device."

Regarding the separate "sending a request" limitation, after reviewing the record before us, it is our view that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's findings of fact. We agree with the Examiner's determination that Laor teaches the use of cookies that are sent from a server to a client for the purpose of collecting data from that client, and the cookies are a "request for user specific information." (*See* Ans. 12, ll. 9-15).

We turn next to the limitations of recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment, as recited in claim 18. We note that Hudda teaches a server 22 that maintains a database of merchants who are subscribers to the system. The server includes a location analysis program that receives information from a position determination that is processed to allow the server to know

where the consumer is physically located. (*See* Hudda paras. 0059-0060). Hudda further teaches that the position locator is utilized such that the user's location can be made known to a server having an electronic yellow pages (i.e., "recognized") via the device's GPS signal. (*See Id.* para. 0044). Still further, we note that the user of the wireless device can designate an acceptable range from their given location to the server. (*Id.*).

As discussed *supra*, the language of claim 18 does not require that the recognition of the wireless device is triggered by the user entering the establishment. In accordance with this construction, we find that the scope of Appellants' claimed "recognizing the presence of the personal wireless device transceiver" broadly but reasonably encompasses Hudda's system that relates the user of the wireless device to the server. It is our view that the acceptable range of the wireless device from the server, as taught by Hudda, reasonably suggests recognizing the wireless device being within the establishment. Accordingly, we conclude that Appellants have not shown that the Examiner erred in determining that the cited references teach and/or suggest the "recognizing" limitation recited in claim 18.

Because we conclude that Appellants have not shown error in the Examiner's *prima facie* case, we sustain the Examiner's rejection of representative claim 18 (and also claims 19-28 and 38-44) which fall therewith) as being unpatentable over Hudda in view of Laor and Ludtke. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 18-28 and 38-44 under 35 U.S.C. § 103(a) for obviousness.

DECISION

The decision of the Examiner rejecting claims 18-28 and 38-44 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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